

REMARKS

This paper addresses the Final Rejection mailed by the Office on February 26, 2009. No claims have been amended, added or canceled. Accordingly, following the entry of this paper, claims 12-16 will be pending in the present application. Reconsideration is respectfully requested in view of the following remarks.

Consideration of Evidence Submitted in the Reply Brief

It is respectfully requested that the Examiner provide an indication that the exhibits submitted with the Reply Brief filed on January 14, 2008 have been considered. It is noted that the Order from the Board of Patent Appeals and Interferences specifically remanded the case to the Examiner to address the evidence presented in the Appellants' Reply Brief. Applicants believe the noted exhibits are present in the record. However, Applicants can provide new copies of these exhibits if needed.

The Obviousness Rejections

In rejecting the claims of this application as unpatentable (35 USC 103), the Examiner cites five documents, i.e. (1) U.S. Patent No. 4,815,618 to Gach, (2) U.S. Patent No. 6,117,506 to Graboski et al, (3) U.S. Patent No. 6,082,568 to Flanagan, (4) U.S. Patent No. 6,076,334 to Kitahora et al, and (5) U.S. Patent No. 4,141,680 to Kauffman et al.

Establishing *prima facie* Obviousness

As is well established, during patent examination, a claim must first be correctly construed to define the scope and meaning of each contested limitation. *In re Skinner*, 2 USPQ2d 1788, 1788- 89 (B.P.A.I. 1 986). Claims must be "given their [I] broadest reasonable interpretation [2] consistent with the specification." *In re Hyatt*, 21 1 F.3d, 1367, 1372, 54 USPQ.2d 1664, 1667 (Fed. Cir. 2000).

After the claims have been construed, the Examiner must establish a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ.2d 1443, 1444 (Fed. Cir. 1992). To establish a *prima facie* case of obviousness, the Examiner must perform an objective analysis

according to the framework described in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

- (A) Ascertaining the scope and content of the prior art; and
- (B) Ascertaining the differences between the claimed invention and the prior art; and
- (C) Resolving the level of ordinary skill in the pertinent art.

Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. *Id.* at 17-18, 148 USPQ at 467. The question of obviousness must be resolved on the basis of these factual determinations. While each case is different and must be decided on its own facts, the *Graham* factors, including secondary considerations when present, are the controlling inquiries in any obviousness analysis. The *Graham* factors were reaffirmed and relied upon by the Supreme Court in its consideration and determination of obviousness in the fact situation presented in *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. 398, 82 USPQ2d 1385 (2007).

In determining the difference between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences *themselves* would have been obvious, but whether the claimed invention *as a whole* would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A prior art reference and the claimed invention must be considered in their entireties. Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *Cert. denied*, 469 U.S. 851 (1984).

If the Examiner has made out a *prima facie* case of obviousness with properly construed claims, the Office must consider the applicants' response. The Office must then determine whether Examiner's *prima facie* case has been rebutted, and the legal conclusion of obviousness is incorrect on the record as a whole. *In re Kumar*, 418 F.3d 1361, 1368, 76 USPQ.2d 1048,1050 (Fed. Cir. 2005).

The applicants submit that the Final Office Action did not establish a *prima facie* case as a matter of law. Furthermore, it is submitted that the Office Action utilized the advantages of the claimed invention as presented by the patent specification to provide the motivation to combine the references in issue. This is classic legal error and resulted in legally erroneous hindsight picking and choosing of elements in the prior art to try to develop the claimed invention. The Office Action also failed to consider the advantages of the claimed subject as part of the subject matter as a whole under Section 103; and thus, the Office Action also erred in failing to recognize that the advantages, rather than providing a motivation to combine, show that the claimed subject matter is patentable as a matter of law.

Summary of USP 4,815,618 to Gach:

Gach, as its title indicates, is in the field of dispenser closures, which can be contrasted with pourable fluid closures. In the art, a dispenser closure has an overcap and something to aid dispensing of the product, such as a base through which the contents are dispensed. Such dispenser closures are associated with dispensers containing non-fluid items such as non-prescription drugs and other consumable products, as described at column 1, lines 9-11. It is important to note that the type of dispenser containers as in Gach are rarely, if ever, thin-walled containers formed through extrusion blow molding because such relatively small containers generally have few (if any) weight constraints and it is generally desirable that such containers be more sturdy than thin-walled containers. At the priority date of the invention, fluid packaging closures would normally only use a cap or stopper to close the open neck of a container for resealing the container.

The Gach patent provides a container 10 having an open cylinder-neck 14. A closure member 18 includes a downward-extending skirt 22, and a surface 30 of skirt 22 is force-fit into a recess 16 that is provided in cylindrical neck 14. The upper surface of closure member 18 includes a nozzle 34 that is closed by a hinged lid 40 that friction-fits to a rim 54. A disc-like foil 56 extends across the open-top of cylinder-neck 14 and is heat-sealed thereto. The upper surface of foil 56 engages a disc 62, and a pull-ring 66 is attached to disc 62.

Importantly, Gach is devoid of any discussion related to a solution to the problem of mating an injection moulded neck and cap assembly (for example Gach's neck 14 and lid 40

assembly) to an extrusion-blow-moulded bottle (for example Gach's container 10). Thus, Gach provides no teaching of a construction and arrangement that is not sensitive to differences in the dimensional tolerances that may exist between an injection-molded cap and an extrusion-blow-molded bottle

Note that this patent to Gach is discussed at page 6 of the present specification. It is significant that Gach does not describe the manner of molding either container 10 or closure 18, and that Gach does not address the issue of the weight of container 10. Gach requires the force-fitting of skirt 22 onto Gach's container's neck 14. Thus, Gach's container 10 must be of a weight, and of a wall-structure, that will resist this fitting-force. Such physical requirements are not even considered in this reference, because relatively thin-walled containers would generally not be considered in applications such as described in Gach, and therefore these types of issues would not be present. This teaching of Gach is entirely incompatible with the claimed requirement of an extrusion-blow-moulded bottle body.

Summary of USP 6,117,506 to Graboski et al:

The Graboski patent provides an extrusion blow molded bottle 10 having a body portion 12 and a neck portion 13 that contains external threads. In the extrusion blow molding of bottle 10, three resins are used to provide a bottle 10 having an outer layer 14 and an inner layer 16 that contain a colorant such as titanium dioxide, and an intermediate layer 18 that contains a colorant such as black oxide and ultramarine blue. Intermediate layer 18 provides material contained within bottle 10 with protection from degradation by light.

It is noted that Graboski's extrusion blow molded bottle 10 is intended to be used directly with a cap having internal threads, and that Graboski does not provide a solution for the problem of mating a resealable injection moulded cap to an extrusion-blow-moulded bottle.

It is also noted that Graboski is cited only to show a bottle that is made using a extrusion blow molding process. It is admitted that a extrusion blow molding process is per se in the prior art.

Summary of USP 6,082,568 to Flanagan:

The Flanagan patent provides a bottle-container 10 whose top-disposed neck 2 includes external threads 12. A cap 15 includes internal threads 13 that mate with external threads 12. A tamper-evident liner 8 lies intermediate the rim 17 of container 10 and the underside of cap 15 and is attached to one or the other (Col 7 line 22) but not both as the container cap has to be removed to take out the liner. A hinged cover 4 may be lowered to cover an orifice 5 that is carried by cap 15. Container 10 may be made of glass, plastics or laminates (col. 6, lines 45-47), and cap 15 is preferably injection molded (col. 7, lines 1-3). Flanagan is a dispenser closure.

Again, Flanagan's container 10 is intended to be used directly with a cap 15 having internal threads 13, and Flanagan does not provide a solution for the problem of mating a resealable injection moulded cap to an extrusion-blow-moulded bottle.

Argument for the patentability of the claims remaining for consideration in this application:

The Examiner rejects the claims of this application as obvious under the provisions of 35 USC 103. Claims 12 and 16 are the independent claims pending in the application.

Independent claim 12 recites a combination of elements including, for example, a process for bottling a fluid wherein bottle-bodies are extrusion-blow-moulded, filled, and then fitted with an injection-moulded neck-and-a resealable injection-moulded cap.

Independent claim 16 recites (among other things) the combination of an extrusion-blow-moulded bottle-body, an injection-moulded neck-assembly, and a resealable injection moulded cap.

The present invention solves a problem in the prior art that is encountered when one attempts to achieve a good seal between a blow moulded bottle neck and a resealable injection moulded plastic cap (for example see page 2, lines 3-15 of the specification). Each of the independent claims 12 and 16 require the present application's new, unusual and unobvious combination of an extrusion-blow-moulded bottle body, an injection-moulded neck assembly that is fitted to the bottle-body, and a resealable and injection-moulded cap that is fitted to the neck assembly, this combination solving the prior art problem of providing a resealable injection molded cap for an extrusion-blow-moulded bottle body.

The Office Action relies on Gach as disclosing a bottle body, neck assembly, a tearable sealing foil, and a resealable cap. Nothing in the figures or the written description of Gach would suggest an extrusion blow molded bottle body and injection molded neck and cap assembly as claimed. To the contrary, Gach specifically requires the force-fitting of skirt 22 onto the container's neck 14. Thus, Gach's container 10 must be of a weight, and of a wall-structure, that will resist this fitting-force. This teaching of Gach is entirely incompatible with the requirement of finally-rejected claims 12-16 that a bottle in accordance with the present invention is a blow molded, thin-walled bottle. If Gach were to be modified to have a thin-walled container body, the force-fitting of the skirt 22 onto the neck 14 would in many cases deform the container.

The Office Action recognizes that Gach does not disclose that the bottle body is extrusion blow molded, and asserts that Gabroski teaches this limitation. The Office Action goes on to assert that it would have been obvious to one of skill in the art at the time the invention was made to use an extrusion blow molded bottle as taught in Gabroski. The Office Action asserts that such a modification is suggested by Graboski "for protecting its contents from degradation due to light."

It is also noted that Graboski is cited only to show a bottle that is made using a extrusion blow molding process. It is admitted that extrusion blow molding processes and bottles are per se in the prior art. Accordingly, Graboski does not cure the deficiencies of Gach, in that this reference is devoid of disclosure related to an extrusion blow molded bottle body and injection molded neck and cap assembly as claimed.

The Office Action goes on to assert Flanagan as disclosing that a cap and container assembly may be injection molded. Again, this reference does not cure the deficiencies identified with respect to Gach and Graboski. Specifically, this reference provides no disclosure related to an extrusion blow molded bottle body and injection molded neck and cap assembly as claimed.

Thus, even assuming Gach is properly combinable with Graboski and/or Flanagan, none of the references fairly suggest the combination of a blow molded bottle body and injection molded neck and cap assembly as claimed.

The Office Action did not Establish a Prima Facie Case Due To Its use of Advantages From the Specification To Provide The Motivation to Combine, and Its Omission From the Claimed Subject Matter As A Whole The Advantages Resulting From the Claimed Combination

The claimed subject matter is allowable because the Office Action is not considering the claimed invention or the prior art as a whole. In determining the difference between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences *themselves* would have been obvious, but whether the claimed invention *as a whole* would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Advantages of claimed subject matter are a part of the subject matter as a whole under section 103. "The invention as a whole embraces the structure, its properties [advantages], and the problem it solves [advantages it provides]." *In re Wright*, 84 F.2d 1216 (Fed. Cir. 1988). Advantages need not be included in the specification. *In re Chu*, 66 F.3d 292 (Fed Cir 1995). "In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question . . . but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification." *In re Antoine*, 559 F.2d 61 8,691 (CCPA 1977).

If aspects of the subject matter as a whole, such as its advantages, are not taught or suggested by cited references, the combination does not yield the claimed subject as whole and therefore cannot render the subject matter as a whole obvious as a matter of law. See, 35 U.S.C. § 103. In any event, evidence of advantages are part of the difference between the claimed subject matter and the prior art and must be considered in an obvious determination.

Aside from being part of the subject matter as a whole under Section 103, advantages are also inferential evidence of nonobviousness. *Preemption Devices, Inc. v. Minnesota Mining and Mfg. Co.*, 732 F.2d 903 (Fed. Cir. 1984). "Focusing on the obviousness of substitutions and differences, instead of on the invention as a whole, is a legally improper way to simplify the often difficult determination of obviousness." *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F. 2d 720 (Fed. Cir. 1990). The PTO is "obligated to consider all the evidence of the properties of the claimed invention as a whole, compared with those of the prior art." *In re Dillon*, 991 F.2d 688 (Fed. Cir. 1990) (en banc), cert. denied 500 U.S. 904 (1991). Thus, "[t]he relevance of such evidence [i.e., of advantages] is direct [under Section 103] in the sense that the new function

[i.e., advantage] is [sic, can be] a part of the inventive concept, the 'subject as a whole,' which must be obvious under Section 103." Chisum, *Intellectual Property, Copyright, and Trademark*, 7-103, 104 (1980) (cited in Chisum's treatise on Patents at Section 5.03[5]). Advantages are part of the differences between the claimed invention and the prior art to be considered under the analysis articulated in *Graham v. John Deere Co. In re Dillon*, 991 F.2d 688 (Fed. Cir. 1990) (en banc), cert. denied 500 U.S. 904 (1991).

One exemplary advantage of the claimed subject matter is the ability to reliably provide a seal for a container body and neck and cap assembly that have differing tolerances due to their differing methods of manufacture. Additional exemplary advantages of the claimed subject matter include: (i) efficient fluid bottling using containers and neck and cap assemblies, (ii) evidence of tampering with a filled container, and (iii) substantial weight and material savings achieved through the use of an extrusion blow molded container body. (see, e.g., Specification, pages 7-8, and lines 9-11 of page 11).

The Office Action did not cite any of these factors - the problem to be solved and the resulting advantages - as part of the claimed subject matter as a whole under Section 103. On the contrary, the Office Action acknowledged other advantages unrelated to the above-noted advantages, such as protection of container contents from light, but did not acknowledge the advantages provided by the claimed invention or the source of the advantages being the applicants' specification (see, e.g., Office Action, page 4). The Office Action thus failed to establish a *prima facie* case of obviousness, as it failed to consider the advantages as part of the claimed subject matter as a whole. Moreover, as discussed above, since these factors are not taught or suggested by the asserted references, the claimed subject matter as a whole is allowable over the references as a matter of law.

As noted above, the Office Action states that the motivation to make the combination is provided by the advantages unrelated to the claimed invention. For example, significant considerations in container bodies is the weight and material usage of the container, and do not include the motivations described by the Office Action. Rather than finding a proper suggestion or motivation in the references or in the common knowledge of those of ordinary skill at the time of the invention, the Office Action used the road map provided by the claimed invention and

specification to selectively choose pieces from prior art references to try to find a motivation and build the claimed subject matter.

The result was not only less than the claimed subject and subject matter as whole but also a classic application of hindsight contrary to law. *Ecolchem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1372, 56 USPQ.2d 1065, 1073 (Fed. Cir. 2000). Moreover, were such an analysis proper, every advantageous invention would be unpatentable.

The applicants submit that the prohibition on hindsight reconstruction is merely another way of saying that the record must provide articulated reasoning supporting the conclusion of obviousness. The Office Action provides no such articulated reasoning, and for yet another reason the Office Action did not make out a *prima facie* case of obviousness.

In sum, claims 12 and 16 are allowable as a matter of law because of the lack of a *prima facie* case of obviousness. Even assuming a *prima facie* case, Applicants have still rebutted the conclusion of obviousness based on the asserted combination's inability to yield the claimed subject matter, and the absence of any teaching or suggestion of the many advantages of the claimed subject matter, the lack of motivation or suggestion to combine the references in the record, and the classically erroneous application of hindsight to make the purported combination from Gach, Graboski, and Flanagan.

The Dependent Claims

Claims 13-15 depend (directly or indirectly) from independent claim 12. Accordingly, it is submitted that these claims are allowable for at least the same reasons as described with respect to claim 12. These claims also contain other, independent bases for patentability, and the right to assert any other such reason in the future is reserved.

Authorization to Charge Fees

No claim related fees are believed to be due with this response. In the event any such fees are due, please debit Deposit Account 08-2623. In the event that a petition for extension of time under 37 CFR §1.136(a) is required to have this reply considered and such a petition does not otherwise accompany this reply, please consider this a petition for an extension of time for

the required number of months and authorization to debit Deposit Account 08-2623 for the required fee.

Conclusion

The application now appearing to be in form for allowance, reconsideration and allowance thereof is respectfully requested. If a telephone conversation will further the prosecution and/or expedite allowance, the examiner is invited to contact the undersigned attorney.

Respectfully submitted,

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